

REMARKS

The outstanding issues in the instant application are as follows:

_____ Claim 15 is rejected under 35 U.S.C. §112, second paragraph; and

_____ Claims 1 – 14 and 16 – 19 are rejected under 35 U.S.C. §102(a/b/e).

Applicants hereby traverse the outstanding rejections and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claim 5 has been canceled without prejudice. Claims 1 – 4 and 6 – 19 are pending in this application.

Claim Rejections Under 35 USC § 112, Second Paragraph

Claim 15 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Examiner states that the phrase “detecting a number said objects” makes no sense. Applicants believe that, as written, the text of claim 15 is understandable by a person of ordinary skill in the art. However, Applicants have amended claim 15 to supply a preposition that was inadvertently omitted. The amended phrase, “detecting a number of said objects” is reflected in the specification at lines 13 – 14 on page 10, “to count the number of objects passed over the optical sensors.” No new matter was added. As each element of indefiniteness cited by the Examiner has been addressed with a corresponding amendment, Applicants respectfully request the rejection of claim 15 under 35 U.S.C. §112, second paragraph be withdrawn.

Claim Rejections Under 35 USC § 102(b)

Claims 1 – 14 and 16 – 19 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,043,877 to Land (hereinafter *Land*). Applicants have amended claim 1 to include the limitation of dependent claim 5. Claims 1 and 9 were also amended to reflect the use of the claimed invention during the normal operation of the system and method described. Support for this amendment is found in the specification’s descriptions of the normal operation of the various embodiments at p. 8, ln 14 through p. 10, ln 20. Claim 16 has been amended to reflect that the illumination source is a “small-intensity” source. Support for this amendment is found in the specification at p. 8, lns 23 – 24. Applicants

have further amended claims 6 – 8 to change the original dependencies to reflect the amendment of claim 1. No new matter has been added.

The Cited Reference Does Not Teach All of the Claim Limitations

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

Claim 1, as amended, defines “a phosphorescent imaging target affixed to an object used in normal operation.” Claim 9, as amended, defines “a phosphorescent target on said object, wherein said object is used in normal operation.” *Land* teaches a calibration method and device for component-placement machines. The calibration of a machine is not normal operation. At column 11, *Land* differentiates between the two stages. In the calibration stage, the components placed by the placement machines are not soldered, but are instead held in place by the adhesive foil on the circuit board used in the calibration process. The calibration stage is described as completely separate and independent from the production stage. Thus, *Land* does not teach the “identical invention” where each element is arranged as described in claims 1 and 9, as amended. Therefore, Applicants respectfully assert that claims 1 and 9, as amended, are patentable over the section 102 rejections of record.

Claim 16, as amended, defines “means for illuminating a region in space using a small-intensity illumination source.” As described in the specification, the use of the phosphorescent targets allows the illumination source within the system to be of smaller-intensity, thus, decreasing the costs of the system. P. 8, lns 23 – 24. *Land* does not teach that the illumination source for its calibration system is any different for the phosphorescent components as for the regular reflective components. Therefore, Applicants respectfully

assert that claim 16, as amended, is patentable over the section 102 rejections of record.

Claims 2 - 4, 6 - 8, 10 - 14, and 17 - 19 from base claims 1, 9, and 16, respectively, and thus inherit all limitations of those respective base claims. Thus, Applicants respectfully assert that, for the above reason, claims 1 - 4, 6 - 14, and 16 - 19 are patentable over the 35 U.S.C. § 102 rejection of record and respectfully request the Examiner to withdraw these rejections.


In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004958-1 from which the undersigned is authorized to draw.

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Date of Deposit: August 11, 2003

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